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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,194	02/01/2001	Eleazar Eskin	12206-002001	7090

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FISH & RICHARDSON P.C.
225 Franklin Street
Boston, MA 02110

EXAMINER

NGUYEN, LEE

ART UNIT	PAPER NUMBER
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2618

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/775,194	ESKIN, ELEAZAR	
	Examiner	Art Unit	
	LEE NGUYEN	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/09/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-17,23-25 and 72-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-17,23-25 and 72-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the communication filed 06/09/2006.

Claims 1-13, 18-22 and 26-71 were canceled. Claims 14-17, 23-25, and 72-76 remain in prosecution.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23-25 and 73 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amended claim 23 and new claim 73 recite the limitation "the communication medium being selected based at least in part on whether the second device is included on the list, and on the fact that the second device is being used by the second identifier user". However, the selection of a communication medium based on both condition was not described as shown in the disclosure, page 5, line 14 through page 6, line 4.

Depend claims 24-25 are rejected for the same reason.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-17, 72 and 74-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokinen et al. (U.S. Publication 2002/0095333) in view of Lehtikoinen et al. (U.S. Publication 2002/0077060).

Regarding claim 14, Jokinen teaches a method comprising: maintaining in a wireless device a list of location-specific information (see current location of the users and areas of interests in [0048]) and/or transaction application capable of receiving information and processing transaction specific to a given application (see redeemed coupons such as electronic coupons in [0048]); on the device, making applications available for use by entities other than the device, see dynamic pricing application 49, typically implemented in software, at server 40 then determines the amount of electronic coupon that is to be sent to a particular user in [0050]; and through a wireless communication channel, broadcasting information from the device indicative of the available application, see [0040], 0054]. Jokinen fails to teach that the wireless device is a handheld wireless device. In an analogous art, Lehtikoinen teaches a portable transceiver 14 which is used

to broadcast services to another wireless devices (see [0030] and [0040]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Lehtikainen with Jokinen in order to provide portability to the broadcast services.

Regarding claim 15, Jokinen also teaches that the information is broadcast periodically, see [0048].

Regarding claim 16, Jokinen also teaches that another wireless device that receives the broadcast information accesses one of the available real-world services, see figure 10 and [0055].

Regarding claim 17, the apparatus claim is interpreted and rejected for the same reason as set forth in the method claim 14.

Regarding claim 72, the method claim is interpreted and rejected for the same reason as set forth in the method claim 14. Jokinen also teaches on a second wireless device, receiving the broadcast information and accessing one of the available applications (see an application at the mobile terminal 20 transforms the packets received by the mobile terminal 20 in a first format in [0044]).

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Regarding claim 74, Jokinen also teaches an application for identifying an actual geographic location of the handheld device based upon signals received from other sources, and in which making the application available includes transmitting the geographic location of the handheld device (see [0065]). Jokinen also teaches in the prior art that GPS sources can be used to determine the location of a device when GPS signals can be obtained (see [0065]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the alternate GPS location determination to the system of Jokinen in order to provide more accurate location of a device when there is no blockage.

Regarding claim 75, Jokinen also teaches accessing one of the available applications includes updating a derived geographic location stored at the second wireless device based on information received from the first device (see [0065]).

Regarding claim 76, Jokinen inherently teaches claimed steps as indicated in the rejection of claim 14 since there are more than one device 40 that perform such steps as shown in figure 1.

Claims 23-25 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irvin (U.S. Patent 6,658,264) in view of Jonsson et al. (US 2003/0036350).

Regarding claim 23, Irvin teaches a method comprising: maintaining a list of short-range wireless devices within range of a first short-range wireless device (col. 8, 59-64, double entry phonebook, walkie-talkie access number, see also walkie-talkie or Bluetooth transceiver in col. 9, lines 2-5); transmitting a message using a communication medium from an identified user of the first device to a second wireless device being used by a second identifier (col. 8, 64-66, place the call), the communication medium being selected based at least in part on whether the second device is included on the list, and inherently on the fact that the second device is being used by the second identifier user, the selection being transparent to the user of the first device (col. 8, 66 through col. 9, 4, see if the cellular number can be associated with a walkie-talkie access number). Irvin does not teach the inherency in the Bluetooth communication system that when in range or to be known within range the Bluetooth devices invoke a service discovery protocol (SDP) so that the devices can know each other when in range. Jonsson teaches that when in range or to be known within range the Bluetooth devices invoke a service discovery protocol (SDP) so that the devices can have the list of desired neighbor devices (see [0003], [0026]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Jonsson to the system of Irvin so that only devices belong to a desired class can be selected.

Regarding claim 24, Irvin also teaches that if the second device is included on the list, the message is transmitted to the second device over a short-range radio link, and if the second device is not included on the list, the message is transmitted to the second

device using another communication medium (col. 8, 64 through col. 9, 4).

Regarding claim 25, Irvin also teaches that if the second device is not included on the list, the message is transmitted to the second device over either the Internet or by mobile telephony (col. 8, 64 through col. 9, 4).

Regarding claim 73, the claims is interpreted and rejected for the same reason as set forth in claim 23.

Response to Arguments

Applicant's arguments filed 06/09/2006 have been fully considered but they are not persuasive.

In the remarks, Applicant contends that neither Jokinen nor Lehtikainen describes a handheld device keeping track of such application on its own, or a handheld device sharing those applications with other such devices.

It is unclear what application in the specification Applicant refers to. The only applications to be found in the specification are methods of doing business as shown in figures 9-13 of the present invention. Jokinen also teaches this kind of method of doing business as demonstrated in the rejection of claim 14.

Applicant further contends that neither Irvin nor Jonsson describes choosing a communication medium based on “the fact that the second identified user is using the second device”.

In response, it is unsure that this limitation is supported by the original description. Assuming it is so, if the second identified user is not using the second device there will be no call to the second party using either walkie-talkie or cellular network as one can see in column 8, line 59 through column 9, line 5 of Irvin.

Conclusion

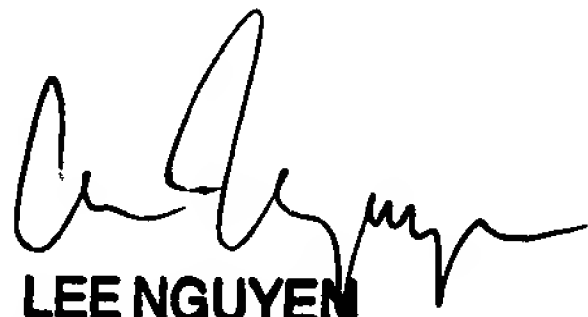
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is 571-272-7854. The examiner can normally be reached on FIRST FRIDAY OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDERSON D. MATTHEW can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


LEE NGUYEN
PRIMARY EXAMINER